



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/665,501

09/22/2003

Mika Sugimoto

0649-0915P

6841

2292 7590 08/13/2008
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

BELANI, KISHIN G

ART UNIT

PAPER NUMBER

2143

NOTIFICATION DATE

DELIVERY MODE

08/13/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/665,501	Applicant(s) SUGIMOTO ET AL.	
	Examiner KISHIN G. BELANI	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/13/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicant's amendment filed on 5/13/2008. **No Claims have been amended, added or cancelled. Claims 1-9** are now pending in the present application. **This Action is made FINAL.**

Specification

The "and" in the title of the invention **suggests two separate and distinct functions**. A distinct (single invention) title is requested that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness

or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)** in view of **Bansal et al. (U.S. Patent Publication # 6,016,338)** and further in view of **Von Kohorn (U.S. Patent Publication # 5,697,844)** and further in view of **Bansal et al. (U.S. Patent Publication # 6,273,816 B1)**.

Consider **claim 1**, Yamaura shows and discloses an e-mail processing server for relaying an e-mail which is transmitted between mobile terminals and performing a lottery to award a prize to a user of the mobile terminal (Abstract; Fig. 1, block 10 marked server; Fig. 5 that shows the process of performing a lottery; paragraph 0008, that discloses an e-mail server providing a mail sending/receiving service to devices

Art Unit: 2143

such as mobile phones, that also writes in a lottery number and an address of a homepage at the end of the e-mail to award prizes to the e-mail recipients), comprising: a receiver for receiving an e-mail from a first mobile terminal and a sender for sending the e-mail to a second mobile terminal (Abstract; Fig. 1, block 13 for sending e-mail to the second user; Fig. 2, blocks S2A01, S2A02, S2A03 for receiving e-mail from the first user; paragraph 0008, lines 1-6, that disclose a sending/receiving service for providing e-mail service; paragraph 0029, lines 1-8 that describe the process of creating an e-mail by the first user; paragraph 0031, lines 5-7 which disclose that after attaching a lottery number to the outgoing e-mail, the e-mail is sent to the second user via SMTP server); and a lot-drawer for executing a lot-drawing from the winning probability decided by the winning probability decider (paragraph 0033, lines 1-5, which disclose that the winning numbers are determined at random from lottery numbers of mail sent within a pre-determined period of time).

However, Yamaura, does not explicitly disclose a storage for storing sent information of the e-mail, which is sent from the receiver or sender, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals; a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the sent information stored in the storage, and wherein if the winning probability results in the second mobile terminal winning a prize, a winning notification is attached to the e-mail sent from said first mobile terminal prior to being reviewed by said second mobile terminal.

In the same field of endeavor, Bansal et al. (**U.S. Patent Publication # 6,016,338**) disclose a storage for storing sent information of the e-mail, which is sent from the receiver or sender, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals (Fig. 2, Memory block 43 that is used to store the sent information (such as number of calls made during a period of time, total amount of call time used, etc.) of calls that are eligible for a lottery; column 5, lines 20-27 that disclose the same details; column 1, lines 64-67 and column 2, lines 1-8 that disclose a lottery system for promoting call volume by awarding prizes based on the number of calls made and the total time spent on calls); Bansal et al. (**in U.S. Patent Publication # 6,273,816**), further discloses that if the winning probability results in the second mobile terminal winning a prize, a winning notification is attached to the e-mail sent from said first mobile terminal prior to being reviewed by said second mobile terminal (abstract that discloses entering an eligible call into a lottery, identifying a group of individuals associated with the call for the purpose of the lottery, and if the call has won the lottery, notifying at least one member of group of the group's winning status; Fig. 3 that shows the step-by-step process disclosed above; column 1, lines 40-45 which disclose that both the wired and wireless communication services are handled; column 2, lines 3-7 which disclose that the group associated with the call for lottery purposes may include at least one of caller, the called party, or some other entity; column 4, lines 30-38 which disclose that a call can be entered into and win a lottery after the communication services have been terminated; thereafter the called

party is notified of the winning lottery status; column 5, lines 42-54 which further disclose that the called party may be notified by an e-mail message).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to provide a storage for storing sent information of the e-mail, which is sent from the receiver or sender, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals, and wherein if the winning probability results in the second mobile terminal winning a prize, a winning notification is attached to the e-mail sent from said first mobile terminal prior to being reviewed by said second mobile terminal as taught by Bansal et al., in the server of Yamaura, so as to generate maximum traffic for the services provided, thereby enhancing the revenue inflow for the company.

However, Yamaura, as modified by Bansal et al., does not explicitly disclose a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the sent information stored in the storage.

In the same field of endeavor, Von Kohorn discloses a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the sent information stored in the storage (column 121, lines 4-38 that while all entered responses in the described contest have a chance of winning a sweepstakes prize, entered responses with superior scores are weighted so as to increase the probability of winning).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the sent information stored in the storage, as taught by Von Kohorn, in the server of Yamaura, as modified by Bansal et al., so that the customers that either receive more e-mails or have larger volume of e-mail content, have better chance of winning the lottery, and therefore, be tempted to continue generating higher email traffic, thereby enhancing the revenue generation for the company.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)** in view of **Bansal et al. (U.S. Patent Publication # 6,016,338 and U.S. Patent Publication # 6,273,816 B1)**, and further in view of **Von Kohorn (U.S. Patent Publication # 5,697,844)**, and further in view of **Noh et al. (U.S. Patent Application Publication # 2001/0051896 A1)**.

Consider **claim 2**, and **as applied to claim 1 above**, Yamaura as modified by Bansal et al. and Von Kohorn, shows and discloses the claimed invention except further comprising a notice information sender for sending notice information, which informs the second mobile terminal that an e-mail has been sent to the recipient; and a request-to-send information receiver for receiving request-to-send information, which is sent from the second mobile terminal, for requesting to send an e-mail that the notice information shows; wherein said sender sends the e-mail to the second mobile terminal

in response to the request-to-send information received by the request-to-send information receiver.

In the same field of endeavor, Noh et al. show and disclose a notice information sending means for sending notice information, which informs the second mobile terminal that an e-mail has been sent to the recipient (Fig. 3F, that shows received mail tray 660 in Outlook Express Window and block 650 which is the notice from the SMTP server to the recipient of the e-mail; paragraph 0086 which indicates the presence of a notice information sending means at the sending server that sent the e-mail notices to the recipient).

Noh et al. also show and disclose a request-to-send information receiver for receiving request-to-send information, which is sent from the second mobile terminal, for requesting to send an e-mail that the notice information shows (Fig. 3G that shows block 651 representing notice from the server, the block containing "acceptance" button 652 as well as "cancel" button; either of which when clicked, requests the sending server to send an e-mail that the notice information shows; which indicates the presence of a request-to-send information receiving means at the sending server).

In addition, Noh et al. also show and disclose that said sender sends the e-mail to the second mobile terminal in response to the request-to-send information received by the request-to-send information receiver (Fig. 3H that shows an advertisement window 651 sent by the server along with the e-mail to the second mobile terminal recipient in response to the recipient clicking on either the "acceptance" button 652 or

the “candle” button in Fig. 3G; which indicates the presence of a sending means for sending an e-mail to the second mobile terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Noh in the server of Yamaura, as modified by Bansal et al. and Von Kohorn, to provide additional means of communications for the second mobile terminal user by giving the user options to either accept the gift and the email or reject the gift and only receive the email by clicking on the appropriate buttons.

Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)** in view of **Bansal et al. (U.S. Patent Publication # 6,016,338)**.

Consider **claim 3**, Yamaura clearly shows and discloses an e-mail processing server for relaying an e-mail which is transmitted between mobile terminals and performing a lottery to award a prize to users of the mobile terminals (Abstract; Fig. 1, block 10 marked server; Fig. 5 that shows the process of performing a lottery; paragraph 0008, that discloses an e-mail server providing a mail sending/receiving service to devices such as mobile phones, that also writes in a lottery number and an address of a homepage at the end of the e-mail to award prizes to the e-mail recipients), comprising:

a sending/receiving unit that receives an e-mail from a first mobile terminal and sending the e-mail to a second mobile terminal (Abstract; Fig. 1, block 13 for sending e-mail to the second user; Fig. 2, blocks S2A01, S2A02, S2A03 for receiving e-mail from the first user; paragraph 0008, lines 1-6, that disclose a sending/receiving service for providing e-mail service; paragraph 0029, lines 1-8 that describe the process of creating an e-mail by the first user; paragraph 0031, lines 5-7 which disclose that after attaching a lottery number to the outgoing e-mail, the e-mail is sent to the second user via SMTP server); and a lot-drawing unit that executes a lot-drawing applied to a user of the second mobile terminal when the sent information stored in the storing unit satisfies a predetermined condition (paragraph 0033, lines 1-5, which disclose that the winning numbers are determined at random from lottery numbers of mail sent within a pre-determined period of time).

However, Yamaura does not specifically disclose a storing unit that stores sent information of the e-mail, which is sent by the sending/receiving unit, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals.

In the same field of endeavor, Bansal et al., disclose a storing unit that stores sent information of the e-mail, which is sent by the sending/receiving means, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals (Fig. 2, Memory block 43 that is used to store the sent information (such as number of calls made during a period of time, total amount of call time used, etc.) of calls that are eligible for a lottery; column 5, lines 20-27 that

disclose the same details; column 1, lines 64-67 and column 2, lines 1-8 that disclose a lottery system for promoting call volume by awarding prizes based on the number of calls made and the total time spent on calls).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to provide a storing unit that stores sent information of the e-mail, which is sent by the sending/receiving unit, the sent information including the number of received e-mails and total amount of received data by said first and second mobile terminals, as taught by Bansal et al., in the server of Yamaura, so as to generate maximum traffic for the services provided, by awarding prizes to their most valuable customers, thereby enhancing the revenue inflow for the company.

Consider **claim 9**, Yamaura shows and discloses a system that monitors emails sent and received by mobile terminals for use in a lottery (Abstract; Fig. 1, block 10 marked server that monitors emails sent and received by mobile terminals for use in a lottery; Fig. 5 that shows the process of performing a lottery; paragraph 0008, that discloses an e-mail server providing a mail sending/receiving service to devices such as mobile phones, that also writes in a lottery number and an address of a homepage at the end of the e-mail to award prizes to the e-mail recipients), comprising:

At least a first and a second mobile terminals (Fig. 1 that shows four different personal computers connected by the Internet; paragraph 0022 which discloses that mobile phones such as cellular phones may also be used as the terminal devices); and

A server which relays the emails sent from one of said first or second mobile terminals to the other (Fig. 1, block 10 marked server which relays the emails (in block 13) sent from one of said first or second mobile terminals to the other); wherein the server determines a winner of a prize using at least part of the mobile terminal information (paragraph 0033, lines 1-5, which disclose that the winning numbers are determined at random from lottery numbers (User Registration file being searched for mail addresses corresponding to the winning lottery number) of mail sent within a pre-determined period of time).

However, Yamaura, does not specifically disclose the server storing mobile terminal information which includes the number of emails received by each of the at least the first and second mobile terminals and also the total amount of data received by each of the at least first and second mobile terminals.

In the same field of endeavor, Bansal et al. disclose a controller storing mobile terminal information which includes the number of calls received by each of the at least the first and second mobile terminals and also the total amount of call time used by each of the at least first and second mobile terminals (Fig. 2, Memory block 43 that is used to store the sent information (such as number of calls made during a period of time, total amount of call time used, etc.) of calls that are eligible for a lottery; column 5, lines 20-27 that disclose the same details; column 1, lines 64-67 and column 2, lines 1-8 that disclose a lottery system for promoting call volume by awarding prizes based on the number of calls made and the total time spent on calls).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to provide a system for storing mobile terminal information which includes the number of emails received by each of the at least the first and second mobile terminals and also the total amount of data received by each of the at least first and second mobile terminals, as taught by Bansal et al., in the system of Yamaura, so as to generate maximum traffic for the services provided, thereby enhancing the revenue inflow for the company.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)**, in view of **Bansal et al. (U.S. Patent Publication # 6,016,338)**, and further in view of **Noh et al. (U.S. Patent Application Publication # 2001/0051896 A1)**.

Consider **claim 4**, and **as applied to claim 3 above**, Yamaura shows and discloses that the sending/receiving unit includes:
a receiving unit that receives the e-mail from the first mobile terminal (Fig. 2, blocks S2A01, S2A02, S2A03 for receiving e-mail from the first user; paragraph 0008, lines 1-6, that disclose a sending/receiving service for providing e-mail service to mobile phones over a network; paragraph 0029, lines 1-8 that describe the process of creating an e-mail by the first user);

However, Yamaura does not explicitly disclose a notice information sending unit that sends notice information, which informs the second mobile terminal that an e-mail

has been sent to the recipient; a request-to-send information receiving unit that receives request-to-send information, which is sent from the second mobile terminal, for requesting to send an e-mail that the notice information shows; and a sending unit that sends the e-mail to the second mobile terminal in response to the request-to-send information received by the request-to-send information receiving unit.

In the same field of endeavor, Noh et al. show and disclose a notice information sending unit that sends notice information, which informs the second mobile terminal that an e-mail has been sent to the recipient (Fig. 3F, that shows received mail tray 660 in Outlook Express Window and block 650 which is the notice from the SMTP server to the recipient of the e-mail; paragraph 0086 which indicates the presence of a notice information sending means at the sending server that sent the e-mail notices to the recipient).

Noh et al. also show and disclose a request-to-send information receiving unit that receives request-to-send information, which is sent from the second mobile terminal, for requesting to send an e-mail that the notice information shows (Fig. 3G that shows block 651 representing notice from the server, the block containing "acceptance" button 652 as well as "cancel" button; either of which when clicked, requests the sending server to send an e-mail that the notice information shows; which indicates the presence of a request-to-send information receiving means at the sending server).

In addition, Noh et al. also show and disclose a sending unit that sends the e-mail to the second mobile terminal in response to the request-to-send information received by the request-to-send information receiving unit (Fig. 3H that shows an

advertisement window 651 sent by the server along with the e-mail to the second mobile terminal recipient in response to the recipient clicking on either the “acceptance” button 652 or the “cancel” button in Fig. 3G; which indicates the presence of a sending means for sending an e-mail to the second mobile terminal).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Noh in the server of Yamaura, as modified by Bansal et al., to provide additional means of communications for the second mobile terminal user by giving the user options to either accept the gift and the email or reject the gift and only receive the email by clicking on the appropriate buttons.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)**, in view of **Bansal et al. (U.S. Patent Publication # 6,016,338 and U.S. Patent Publication # 6,273,816 B1)**, and further in view of **Von Kohorn (U.S. Patent Publication # 5,697,844)**, and further in view of **Acres (U.S. Patent Application Publication # 2002/0061778 A1)**.

Consider **claim 5**, and **as applied to claim 1 above**, Yamaura as modified by Bansal et al. and Von Kohorn, shows and discloses an e-mail processing server. Yamaura also discloses sending e-mail to the second mobile terminal with a URL link to the web site that stores a prize information database (Fig. 8, block 35; paragraph 0048,

which discloses that the e-mail includes prize information and homepage address in the form of a URL link).

Yamaura, as modified by Bansal et al. and Von Kohorn, however does not explicitly disclose that the e-mail processing server further comprises an acquiring device for acquiring, from a database, storing location information showing a location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored.

Yamaura, as modified by Bansal et al. and Von Kohorn, also fails to disclose that the e-mail processing server in addition comprises a storing location information sender for attaching the storing location information acquired by the acquiring device to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal.

In the same field of endeavor, Acres shows and discloses an acquiring device for acquiring, from a database, storing location information showing a location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored (Fig. 10, blocks 1020, 1025, and 1027; paragraph 0033, lines 23-28, which disclose an acquiring means (game program database 1025 in the game/redemption server 1020) and a reward redemption database 1027 that the game program 1025 searches for the prize won by the user; Fig. 9, block 909; paragraph 0032, lines 18-20, which describe that the redemption routine displays a reward web page in order to facilitate selection and delivery of the reward, thereby disclosing an acquiring means that provides the location of awarded prizes); and

storing location information sender for attaching the storing location information acquired by the acquiring device to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal (Fig. 8, block 815; paragraph 0031, lines 28-29, which disclose that the game program displays a link to a redemption web site).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Acres, in the server of Yamaura as modified by Bansal et al. and Von Kohorn, to provide means of searching the prize information database for the purpose of supplying the URL address of the prize information database in an email to the recipient so as to help the winner recipient quickly claim his or her prize.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)**, in view of **Bansal et al. (U.S. Patent Publication # 6,016,338)**, and further in view of **Acres (U.S. Patent Application Publication # 2002/0061778 A1)**.

Consider **claim 6**, and **as applied to claim 3 above**, Yamaura clearly shows and discloses an e-mail processing server. Yamaura also discloses sending an e-mail to the second mobile terminal with a URL link to the web site that stores a prize information database (Fig. 8, block 35; paragraph 0048, which discloses that the e-mail includes prize information and homepage address in the form of a URL link).

However, Yamaura does not explicitly disclose that the e-mail processing server further comprises an acquiring unit that acquires from a database, storing location information showing storing location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored.

Yamaura also fails to disclose that the e-mail processing server in addition comprises a storing location information sending unit that attaches the storing location information acquired by the acquiring unit to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal.

In the same field of endeavor, Acres shows and discloses an acquiring unit that acquires from a database, storing location information showing storing location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored (Fig. 10, blocks 1020, 1025, and 1027; paragraph 0033, lines 23-28, which disclose an acquiring means (game program database 1025 in the game/redemption server 1020) and a reward redemption database 1027 that the game program 1025 searches for the prize won by the user; Fig. 9, block 909; paragraph 0032, lines 18-20, which describe that the redemption routine displays a reward web page in order to facilitate selection and delivery of the reward, thereby disclosing an acquiring means that provides the location of awarded prizes); and storing location information sending means for attaching the storing location information acquired by the acquiring unit to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal

(Fig. 8, block 815; paragraph 0031, lines 28-29, which disclose that the game program displays a link to a redemption web site).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Acres in the server of Yamaura, as modified by Bansal et al., to provide means of searching the prize information database for the purpose of supplying the URL address of the prize information database in an email to the recipient so as to help the winner recipient quickly claim his or her prize.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaura (U.S. Patent Application Publication # 2002/0016199 A1), in view of Bansal et al. (U.S. Patent Publication # 6,016,338 and U.S. Patent Publication # 6,273,816 B1), and further in view of Von Kohorn (U.S. Patent Publication # 5,697,844), and further in view of Acres (U.S. Patent Application Publication # 2002/0061778 A1), and further in view of Landress et al. (U.S. Patent Application Publication # 2003/0191816 A1).

Consider **claim 7**, and **as applied to claim 1 above**, Yamaura, as modified by Bansal et al. and Von Kohorn, show and disclose an e-mail processing server. Yamaura also discloses sending e-mail to the second mobile terminal with a URL link to the web site that stores a prize information database (Fig. 8, block 35; paragraph 0048,

which discloses that the e-mail includes prize information and homepage address in the form of a URL link).

However, Yamaura, as modified by Bansal et al. and Von Kohorn, fails to disclose that the e-mail processing server further comprises an acquiring device for acquiring, from a database, storing location information showing a location on a network, where the digital contents are stored.

Yamaura, as modified by Bansal et al. and Von Kohorn, also fails to disclose that the e-mail processing server in addition comprises a storing location information sender for attaching the storing location information acquired by the acquiring device to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal.

In the same field of endeavor, Acres clearly shows and discloses an acquiring means for acquiring storing location information showing storing location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored, from a database (Fig. 10, blocks 1020, 1025, and 1027; paragraph 0033, lines 23-28, which disclose an acquiring means (game program database 1025 in the game/redemption server 1020) and a reward redemption database 1027 that the game program 1025 searches for the prize won by the user; Fig. 9, block 909; paragraph 0032, lines 18-20, which describe that the redemption routine displays a reward web page in order to facilitate selection and delivery of the reward, thereby disclosing an acquiring means that provides the location of awarded prizes); and

storing location information sending means for attaching the storing location information acquired by the acquiring means to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal (Fig. 8, block 815; paragraph 0031, lines 28-29, which disclose that the game program displays a link to a redemption web site).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Acres in the server of Yamaura, as modified by Bansal et al. and Von Kohorn, to provide means of searching the prize information database for the purpose of supplying the URL address of the prize information database in an email to the recipient so as to help the winner recipient quickly claim his or her prize.

However, Yamaura, as modified by Bansal et al. and Von Kohorn and further modified by Acres, fails to disclose that the prize involves digital contents that are enabled to play with the mobile terminal.

In the same field of endeavor, Landress et al., disclose a system for delivering customized multimedia communications (Abstract that disclose communicating personalized entertainment such as screensavers, reminder services, etc. integrally associated with sponsorship or advertisement information via the Internet or e-mail; paragraph 0004 that also specifies wireless networks used by cell phone users as delivery channels for the media delivery; paragraph 0016 additionally lists promotional “jingles” equivalent to cell phone ring tones and other audio segments (paragraph 0061, lines 1-5) as additional multimedia items to be delivered; paragraph 0060 that discloses

an e-mail server 28a included in the web server 28 that allows users to send/receive e-mails; paragraph 0146, lines 8-11 that disclose the use of cellular phones in the system)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide prizes, such as screensavers and cell phone ring tones, as taught by Landress et al. in the system of Yamaura, as modified by Bansal et al., Von Kohorn, and Acres, to provide instant enjoyment of the prize that the recipient can play on a mobile terminal.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Yamaura (U.S. Patent Application Publication # 2002/0016199 A1)**, in view of **Bansal et al. (U.S. Patent Publication # 6,016,338)**, and further in view of **Acres (U.S. Patent Application Publication # 2002/0061778 A1)**, and further in view of **Landress et al. (U.S. Patent Application Publication # 2003/0191816 A1)**.

Consider **claim 8**, and **as applied to claim 3 above**, Yamaura, as modified by Bansal et al., shows and discloses an e-mail processing server. Yamaura, as modified by Bansal et al., also discloses sending e-mail to the second mobile terminal with a URL link to the web site that stores a prize information database (Fig. 8, block 35; paragraph 0048, which discloses that the e-mail includes prize information and homepage address in the form of a URL link).

However, Yamaura, as modified by Bansal et al., does not explicitly disclose that the e-mail processing server further comprises an acquiring unit that acquires storing

location information showing storing location on a network, where the digital contents are stored, from a database.

Yamaura, as modified by Bansal et al., also fails to disclose that the e-mail processing server in addition comprises a storing location information sending unit that attaches the storing location information acquired by the acquiring unit to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal.

In the same field of endeavor, Acres shows and discloses an acquiring unit that acquires storing location information showing storing location on a network, where contents of a prize awarded to a user who won the lot-drawing are stored, from a database (Fig. 10, blocks 1020, 1025, and 1027; paragraph 0033, lines 23-28, which disclose an acquiring means (game program database 1025 in the game/redemption server 1020) and a reward redemption database 1027 that the game program 1025 searches for the prize won by the user; Fig. 9, block 909; paragraph 0032, lines 18-20, which describe that the redemption routine displays a reward web page in order to facilitate selection and delivery of the reward, thereby disclosing an acquiring means that provides the location of awarded prizes); and storing location information sending unit that attaches the storing location information acquired by the acquiring unit to an e-mail, which is to be sent to a mobile terminal of the user who won the lot-drawing, and then sending the e-mail to the mobile terminal (Fig. 8, block 815; paragraph 0031, lines 28-29, which disclose that the game program displays a link to a redemption web site).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the concept taught by Acres in the server of Yamaura, as modified by Bansal et al., to provide a unit for searching the prize information database for the purpose of supplying the URL address of the prize information database in an email to the recipient so as to help the winning recipient quickly claim his or her prize.

However, Yamaura as modified by Bansal et al. and Acres, fail to disclose that the prize involves digital contents that are enabled to play with the mobile terminal.

In the same field of endeavor, Landress et al. disclose a system for delivering customized multimedia communications (Abstract that disclose communicating personalized entertainment such as screensavers, reminder services, etc. integrally associated with sponsorship or advertisement information via the Internet or e-mail; paragraph 0004 that also specifies wireless networks used by cell phone users as delivery channels for the media delivery; paragraph 0016 additionally lists promotional “jingles” equivalent to cell phone ring tones and other audio segments (paragraph 0061, lines 1-5) as additional multimedia items to be delivered; paragraph 0060 that discloses an e-mail server 28a included in the web server 28 that allows users to send/receive e-mails; paragraph 0146, lines 8-11 that disclose the use of cellular phones in the system).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide prizes, such as screensavers and cell phone ring tones, as taught by Landress et al. in the server of Yamaura, as modified by Bansal

et al. and Acres, in order to provide instant enjoyment of the prize that the winning recipient can play on the mobile terminal.

Response to Arguments

Applicants' arguments filed 05/13/2008 with respect to **independent claims 1, 3, and 9**, and their dependent claims have been fully considered but are not persuasive, as the cited references provide adequate disclosure and support to **reject claims 1-9**.

The examiner's response to the submitted arguments is shown below:

The applicants argue that in the cited Yamaura reference (US Patent Application Publication # 2002/0016199 A1), the sender of the email and not the recipient is eligible to win a lottery. The examiner respectfully disagrees. Fig. 5, steps S509-S514 clearly show that the email recipient and not the sender is awarded lottery gift. Paragraphs 0049-0050 further disclose the same details.

The applicants further argue that the "lottery numbers in the Yamaura reference are completely random and have nothing to do with being selected based on information associated with emails sent to a particular mobile terminal". The examiner begs to differ. Even if the lottery numbers were random, a large number of such random number containing emails sent to a particular recipient increases the probability of winning a lottery by that recipient, and therefore, there is an association between being selected as a winner and the number of emails containing random lottery numbers sent to a particular mobile terminal.

The applicants further argue that the “total amount of call time” in the Bansal et al. reference (US Patent Publication # 6,106,338) does not correspond to the claimed “total amount of received data”, declaring that “**Total time and total data are not the same**”. Again, the examiner respectfully disagrees. When voice is converted to digital bits (VOIP protocol) for transmission as packets over the Internet, or attached to email messages, the total talk time will affect how much digital data is produced during the conversion of voice to digital bits. A one minute call time will produce less digital bits than a five minute call time, bandwidth of a communication path notwithstanding. Any common text book on conversion of voice to digital data will teach this claim element.

Furthermore, the applicants allege that neither Yamaura nor Bansal teach or suggest attaching to the email sent between a first and a second terminal, a winning notification prior to the email being received by the second terminal. Again, the examiner would like to point to Fig. 5 in Yamaura reference, wherein in steps S506-S507, an award controller attaches a lottery number to the email being sent to the recipient. Since, at least one of these lottery numbers will produce a winning lottery; the examiner has interpreted it as a winning notification that is attached to the email sent by a first terminal to a second terminal, prior to the email being received by the second terminal. Thus, Yamaura does teach the claimed feature argued above. The applicants further state that Bansal et al. reference does not teach this feature also, since in the Bansal et al. reference, “the first mobile terminal is not a controller”. The examiner is not quite clear what the applicants are arguing about. The winning notification is not provided by the first mobile terminal in either the cited references or the applicants’ own

Art Unit: 2143

invention, but is added by an award controller/distributor prior to the delivery of the message to the intended recipient, which is what happens in the Yamaura and Bansal references as well.

The examiner has thus responded to all the arguments presented by the applicants. Therefore, **the rejections of the independent claims 1, 3, and 9, as well as their dependent claims 2 and 4-8 are maintained.**

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: 2143

Art Unit: 2143

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kishin G. Belani whose telephone number is (571) 270-1768. The Examiner can normally be reached on Monday-Friday from 6:00 am to 5:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tonia Dollinger can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-0800.

Application/Control Number: 10/665,501
Art Unit: 2143

Page 29

***/Kishin G Belani/
Examiner, Art Unit 2143***

August 8, 2008

/Tonia LM Dollinger/
Supervisory Patent Examiner, Art Unit 2181